

Appl. No. 10/061,727
Amdt. dated July 23, 2004
Resp. to Office Action dated February 24, 2004

REMARKS

In view of the foregoing amendment and the following response, Applicants respectfully request reconsideration of the claims pending in this application. Claims 1-14 are pending. Claims 1, 2 and 7 have been allowed. Claims 5 (as to SEQ ID NOS: 1 and 2), 6, 9, 10 and 11 are the subject of this examination. Claim 5 part h) is amended. In the discussion that follows Applicants address each of the rejections and objections in the order that they appear in the Office Action mailed February 24, 2004.

The Examiner maintains the previous rejection of claims 5, 6, 9, and 10 under 35 U.S.C. 112, first paragraph. This rejection is particularly directed to claim 5, part h). The Examiner is of the opinion that the moderate stringency hybridization conditions result in hybridized molecules with structural features that encompass a genus of unrelated structures. The Examiner simply concludes that moderate stringency conditions yield structurally unrelated molecules without providing sound scientific basis for the conclusion. Applicants respectfully submit that hybridization conditions of moderate stringency do result in nucleic acids that encompass polypeptides having structurally related features and functionally related characteristics. In fact moderate stringencies conditions are used to find structurally related molecules in biological systems. Nevertheless, Applicants amend part h) of claim 5 to recite stringent conditions. Support for this amendment is found on page 10 lines 28 through 33.

In view of the above remarks and amended claim 5, Applicants respectfully submit that amended claim 5 is fully enabled and Applicants request that the Examiner withdraw the rejection of claim 5 under 35 U.S.C. 112, first paragraph, for enablement. Claims 6, 9, and 10 depend from claim 5 and since claim 5 should be deemed enabled, these claims are also enabled.

In a new ground for rejection the Examiner rejects claims 10 and 11 under 35 U.S.C. 112, second paragraph, as being indefinite. The Examiner is of the opinion that claims 10 and 11 are unclear as to what protein is to be made by the claimed process and the claims read on any protein produced by the cell. Claims 10 and 11 are amended to more specifically recite the expressed polypeptide. In view of this amendment, Applicants request that the rejection be withdrawn.

In a confusing rejection, the Examiner rejects claims 5, 6, 9, and 10 under 35 U.S.C. 102(b) as being anticipated by Saeiki et al. (Database Swiss-Prot. Accession No. P35413, 1997) "as set forth at pages 10-11 of the previous office action." There is no Saeiki et al. reference cited in the previous office action and no Accession No. P35413 mentioned in the previous office action. Applicants respectfully request clarification.

Since the rejection over Huang et al. made in the previous office action is not withdrawn and the Examiner refers to Huang et al. in paragraph 3 of this rejection, Applicants address the previous rejection under Section 102(b) over Huang et al. The

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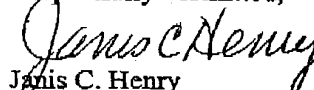
NO:1 and thus would hybridize to the polynucleotide of SEQ ID NO:1 under conditions of moderate stringency. Applicants respectfully submit that the Examiner provides no sound basis for such a conclusion. Merely stating a conclusion is insufficient to support this rejection and without more this is improper. Nevertheless, by the above amendment, Applicants amend claim 5 to recite high stringency hybridization conditions. In view of this amendment Applicants respectfully request this rejection be withdrawn.

The Examiner further maintains the rejection of claims 5, 6, 9, and 10 under 35 U.S.C. 102(e) as being anticipated by the Cao reference. In view of the amendment to claim 5, and for the reasons described above relevant to the Huang et al. reference, Applicants respectfully submit that this rejection is overcome and request that the Examiner withdraw rejection. As for claim 6, 9, and 10, these too are not anticipated and their rejection should be withdrawn.

Finally, the Examiner objects to claims 5, 6, and 9 for reciting unelected subject matter related to SEQ ID NO:4. By the above, unelected subject matter is withdrawn.

In view of the foregoing remarks and amendments, Applicants submit that the claims pending in this application are in condition for allowance and respectfully request a notice to that effect.

Respectfully submitted,


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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office on the date indicated below.

Signed: 
Nanci M. Kertson

Date: July 23, 2004